

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:	William E. Mazzara, Jr.
Serial Number:	10/736,491
Filing Date:	December 15, 2003
Confirmation No.:	3801
Examiner/Group Art Unit:	Oluseye Iwarere/3687
Title:	METHOD AND SYSTEM FOR MANAGING PROMOTIONAL TELEMATICS SERVICES

APPEAL BRIEF

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Please enter the following Appeal Brief in the appeal filed September 9, 2009.

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I. REAL PARTY IN INTEREST

The real parties in interest are OnStar Corporation and Assignee General Motors Company, each having an office and a place of business at 300 Renaissance Center, Detroit, Michigan, 48265-3000.

II. RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorney are not aware of any appeals or any interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 22-30 are the claims on appeal. *See*, Appendix.

Claims 1-21 were cancelled.

Claims 22-30 were rejected.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action of June 9, 2009, no amendment pursuant to 37 C.F.R. § 1.116 was filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In this summary of claimed subject matter, all citations are to the specification of United States Patent Application 10/736,491. Further, all citations are illustrative, and support for the cited element may be found elsewhere in the specification.

Independent claim 22:

Independent claim 22 is directed to a system for providing a telematics service to a mobile vehicle. With reference to Figs. 1-4 of Appellant's application as filed, the system includes: a communications unit (such as, e.g., a telematics unit 120, 220) in the mobile vehicle 210 for connecting to a remote location (such as, e.g., a call center 170) (see page 7, lines 23-26 and page 10, lines 2-16 of Appellant's application as filed); a response system (such as, e.g., communication services manager 174) at the remote location 170 providing at least one promotional service as a choice to a user in the mobile vehicle 210 (see page 8, lines 14-23, page 13, lines 2-6, and page 16, lines 5-11 of Appellant's application as filed); a timing unit (such as, e.g., a vehicle system module 290) associated with the communication unit 120, 220, responsive to the response system 174, wherein the timing unit 290 is configured to monitor a period of free use of the at least one promotional service by the user of the mobile vehicle 210 (see page 11, line 10 through page 12, line 4, page 15, lines 10-17, and page 16, lines 16-22 of Appellant's application as filed); and means for charging the user a fee for use, occurring after the period of free use expires, of the at least one promotional service (see pages 14-16 of Appellant's application as filed).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 22-30 are unpatentable under 35 U.S.C. § 103(a) over Kolls (U.S. Patent No. 6,615,186, referred to herein as “Kolls”) in view of Muratani, et al. (U.S. Patent No. 6,119,109, referred to herein as “Muratani”).

VII. ARGUMENTS

The arguments presented hereinbelow address the rejections stated in the Final Office Action dated June 9, 2009. It is submitted, however, that the absence of a reply to a specific rejection, issue or comment in the Final Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in the following arguments of this appeal brief should be construed as an intent to concede any issue with regard to any claim, except as specifically stated below.

A. Rejection of claims 22-30 under 35 U.S.C. § 103(a) over Kolls and Muratani

In the Final Office Action dated June 9, 2009, claims 22-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kolls and Muratani. The Examiner asserts that Kolls teaches all of the elements of independent claim 22 including 1) a response system at a remote location *providing at least one promotional service as a choice to a user in a mobile vehicle*, and 2) a timing unit associated with a communications unit, responsive to a response system, *wherein the timing unit is configured to monitor a period of free use of the at least one promotional service by the user in the mobile vehicle*. The Examiner admits that Kolls fails to teach a period of free use, but he relies on Muratani to supply this deficiency. The Examiner concludes that it would have been obvious to modify the system of Kolls to include the period of free use taught by Muratani in order to provide billing service to a user.

At the outset, obviousness is a question of law based on i) the scope and content of the prior art, ii) *the differences between the prior art and the claims at issue*, iii) the level of ordinary skill in the art, and iv) objective evidence of non-obviousness (*Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966)). An invention may be obvious if it merely combines “familiar elements according to known methods [to] yield predictable results” (*KSR Int. Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727; 167 L.Ed.2d 705; 2007 U.S. LEXIS 4745; 75 U.S.L.W. 4289; 82 USPQ2d 1385 (2007)).

A basic requirement to establish a case that a claim is *prima facie* obvious is that “*the prior art reference (or references when combined) must teach or suggest all the claim limitations*” (emphasis added; see MPEP § 2143). “In proceeding before the Patent and

Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art” (*In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)). “If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent” (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).

In light of the precedent cited above, Appellant submits that the combination of Kolls and Muratani must disclose all of the elements of the rejected claims to establish a *prima facie* case of obviousness. For the reasons provided hereinbelow, Appellant submits that the Examiner has *failed to do so*.

Kolls discloses an in-vehicle device that communicates with various data processing resources for transacting e-commerce and e-business (see Abstract of Kolls). For example, and with reference to Figs 1B-1J of Kolls, an in-vehicle device 200 may wirelessly communicate with various communication interface (COM) devices 100 (or response systems as allegedly referred to by the Examiner), which are located in a plurality of physical locations (see column 5, line 60 through column 6, line 7). The COM devices 100 may be, e.g., interconnected with a garage door opener (column 7, lines 48-49 and Fig. 1C of Kolls), interconnected with a gas pump (column 7, lines 55-56 and Fig. 1D of Kolls), interconnected with a tollbooth (column 7, lines 66-67 and Fig. 1E of Kolls), interconnected with a traffic light pole (column 8, lines 14-15 and Fig. 1F of Kolls), interconnected with a parking gate (column 8, lines 28-29 and Fig. 1H of Kolls), and the like.

In an example, Kolls’s COM device 100 is configured to cache data communicated to it via the Internet based on data from, e.g., the in-vehicle device 200. When the vehicle comes into wireless proximity with the COM device 100, the vehicle may be commanded to stop, and data may be wirelessly communicated between the devices 100, 200 (see column 6, lines 27-46). Such data may be, e.g., information related to the vehicle, such as make, model, feature set, diagnostic data, vehicle telemetry, vehicle metrics, and other data (see column 8, lines 47-52). The data may be used by, e.g., auto parts stores to automatically evaluate, diagnose, identify parts, or recommend vehicle services. Also, access to the Internet allows either of the devices

100, 200 to query information related to warranty, service, parts, coupons, special offers, and other vehicle service or maintenance data. (See column 8, lines 53-65 of Kolls.)

Appellant submits that Kolls does *not* disclose or even suggest that the COM devices 100 that interconnect to the other devices in the various physical locations provide at least one *promotional service* to a user of the vehicle. In the examples of Kolls identified above, coupons and/or special offers may, in some instances, be considered promotional services. However, the alleged response systems of Kolls (i.e., the COM devices 100) do *not* provide the coupons and/or special offers to the user of the vehicle. Such services are instead queried *from the Internet*. Thus, Appellant respectfully submits that Kolls *fails* to teach a response system at the remote location, where the response system provides *at least one promotional service* in the mobile vehicle.

Further, Appellant submits that Kolls does *not* disclose or even suggest that the COM devices 100 provide at least one promotional service (or any service for that matter) as a choice to the user of the vehicle. To reiterate from above, Kolls teaches that when the in-vehicle device 200 is in wireless proximity with a COM device 100, the vehicle *automatically* stops and communicates information to and/or from the COM device 100. Kolls does *not* teach that the user of the vehicle may choose what information is communicated to the COM device 100 and/or what information is communicated from the COM device 100 to the in-vehicle device 200. As disclosed in Kolls, the information communicated between the devices 100, 200 may ultimately be used for tracking engine performance over time for different makes and models of vehicles, better serving customer needs, anticipating vehicle part requirements and service needs in an effort to sell customers parts or services that they may not know they need, or to enhance warranty programs or offerings by the manufacturer, parts, suppliers, or stores. (See column 9, lines 19-25 of Kolls.)

Additionally, in the Final Office Action dated June 9, 2009, the Examiner cites column 53, line 63 through column 54, line 6 and Fig. 18 of Kolls, asserting that this portion of the Kolls reference discloses providing a promotional service as a choice to a user in the mobile vehicle. This cited portion of the Kolls reference specifically states, in part:

An Internet based audio and video server routine allows a user to select music and video. Music and video can be selected at an in-vehicle device 200. A menu system can allow a user to selectively download or stream the audio and video data for storage or playback.

Appellant, however, fails to see how the foregoing cited portion of the Kolls reference teaches a *promotional service as a choice* to a user. As generally understood by one skilled in the art, a promotional service refers to a service devised to *publicize or advertise* a product, service, etc. in order to further the growth or development of the product, service, etc. Such is the *plain meaning* of the term as recognized by, for example, many dictionaries including the Merriam-Webster online dictionary. Appellant submits that allowing a user to select music and video (as taught in column 53, line 63 through column 54, line 6 of Kolls) does *not* in and of itself classify the music and video as a promotional service. Such cannot be concluded at least because the Examiner's cited portion of the Kolls reference does not explicitly disclose or even allude to the fact that the music and video is a promotional product or service. At most, the cited portion of the Kolls disclosure, when taken in light of the entire Kolls reference, classifies the music and video as *the product or service itself*.

Yet further, the system defined in independent claim 22 includes a timing unit associated with the communications unit, responsive to the response system, where the timing unit is configured to *monitor* a period of free use of the at least one promotional service by the user of the vehicle. At the outset, the Examiner submits that the terminology "configured to" is not considered to be a limitation of the claim (citing MPEP §§ 2106(II)(C) and 2111.04). Appellant respectfully disagrees with the Examiner and directs the Board's attention to MPEP § 2111.04, which states that terms such as "adapted to", "whereby", or the like may be considered to be a limitation in a claim so long as the condition is *material to patentability*, and does not simply express an intended result of a process. Appellant submits that a timing unit configured (e.g., set up or constructed for a particular purpose) to monitor a period of free use of at least one promotional service is clearly *not* an intended result of a process; rather such limitation expresses what the timing unit is configured to do. It is therefore submitted that the "configured to" limitation recited in claim 22 is a material limitation of the claim.

Appellant further submits that Kolls *fails* to teach a timing unit associated with the communications unit, responsive to the response system, where the timing unit is configured to **monitor** a period of free use of the at least one promotional service by the user of the vehicle. In addition to the fact that Kolls fails to disclose a period of free use (as admitted by the Examiner), the timing unit referenced in Kolls at column 25, lines 47-54 is a microcontroller having a date and time functionality that, for example, is responsive to various events. Kolls does *not* disclose that the microcontroller is configured to **monitor** a period of free use of a service (such as a promotional service).

The Examiner relies on Muratani to supply the deficiencies of Kolls; namely to establish a period of free use of a service. Muratani is directed to an information distribution system for distributing proprietary information and a billing system to be used in conjunction with the information distribution system (see column 1, lines 5-8). The information distribution system is configured to at least 1) realize a variety of billing methods, and 2) realize an appropriate and efficient billing process that correspond to the contents of the information distributed (see column 3, lines 22-30). The contents of the information may be, for example, **pay content data** such as multimedia information, new information, and book information (see column 9, line 66 through column 7, line 9). In some instances, a free charge is applied for the content in specific situations. For example, a video-on-demand system may have a pay structure such as \$5 per movie, however if only, e.g., 10% or less of the movie is watched, then there is no charge for the movie (see column 18, lines 35-39).

Muratani further discloses at column 19, lines 1-7, “[t]he following billing parameter and change point are described in a case of a billing process which is performed in accordance with a step function or a polygonal line shape function, for example a step function billing in which **“charge free for one minute from beginning, one dollar/minute for 60 minutes following the one minute and fifty cents/minute for the following period”** (emphasis added). Such may be considered to be a period of free use, however, such free use is *not* associated with a **promotional service**.

In the Final Office Action of June 9, 2009, the Examiner construes the video-on-demand as a promotional service. In light of the definition of a promotional service provided

hereinabove, it is submitted that Muratani does *not* disclose or even suggest anywhere in the reference that the video-on-demand is or could be a promotional service.

Additionally, Appellant submits that Muratani also *fails* to supply the other deficiencies of the Kolls reference identified above. Thus, for all of the reasons stated above, it is submitted that the combination of Kolls and Muratani *fails* to disclose all of the elements of independent claim 22. As such, it is further submitted that Appellant's invention as defined in independent claim 22, and in those claims depending therefrom, is not anticipated, taught, or rendered obvious by Kolls and Muratani, either alone or in combination, and patentably defines over the art of record.

SUMMARY

The Appellant respectfully submits that claims 22-30 as currently pending fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

DIERKER & ASSOCIATES, P.C.

/Julia Church Dierker/

Julia Church Dierker
Attorney for Appellant
Registration No. 33368
(248) 649-9900, ext. 25
juliad@troypatent.com

3331 West Big Beaver Rd., Suite 109
Troy, Michigan 48084-2813

Dated: November 6, 2009

JCD/AMS

VIII. CLAIMS APPENDIX

22. (Previously presented) A system for providing a telematics service to a mobile vehicle, the system comprising:

- a communications unit in the mobile vehicle for connecting to a remote location;
- a response system at the remote location providing at least one promotional service as a choice to a user in the mobile vehicle;
- a timing unit associated with the communications unit, responsive to the response system, wherein the timing unit is configured to monitor a period of free use of the at least one promotional service by the user in the mobile vehicle; and
- means for charging the user a fee for use, occurring after the period of free use expires, of the at least one promotional service.

23. (Previously presented) The system as defined in claim 22, further comprising means for receiving a request for the at least one promotional service.

24. (Previously presented) The system as defined in claim 23, further comprising a user interface operatively connected to the communications unit and configured to prompt the user of the mobile vehicle for the request.

25. (Previously presented) The system as defined in claim 22, further comprising means for determining if a period of use, occurring after the period of free use expires, of a previously-

received promotional service exists, wherein the timing unit is further configured to decrement the period of use of the previously-received promotional service from a user account balance.

26. (Previously presented) The system as defined in claim 22, further comprising:

means for determining if the connection between the communications unit and the remote location has been terminated; and

if the connection has been terminated, means for determining if a period of use, occurring after the period of free use expires, of the at least one promotional service exists.

27. (Previously presented) The system as defined in claim 26 wherein if a period of use of the at least one promotional service exists, the timing unit is further configured to decrement the period of use of the at least one promotional service from a user account balance.

28. (Previously presented) The system as defined in claim 22, further comprising means for determining if the at least one promotional service period of free use is greater than zero.

29. (Previously presented) The system as defined in claim 28 wherein if the at least one promotional service period of free use is not greater than zero, the system further comprises:

means for providing the at least one promotional service to the user; and

means for charging a fee to the user of the mobile vehicle for a period of use of the at least one promotional service.

30. (Previously presented) The system as defined in claim 22, further comprising means for providing the at least one promotional service to the user for free during the period of free use.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.